

REMARKS

This paper is responsive to an Office Action mailed March 15, 2007. Prior to this response, claims 1 and 4 were pending. After amending claims 1 and 4, and adding claims 5-23, claims 1, 4, and 5-23 remain pending.

In Section 2 of the Office Action, claims 1 and 4 have been rejected under 35 U.S.C. 112, second paragraph, as indefinite. In response, claims 1 and 4 have been amended to address the problems raised by the Examiner.

In Section 3 of the Office Action, claim 4 has been rejected under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter. Specifically, the Office Action states that a transmitter for transmitting a message containing control information has no practical application. This rejection is traversed as follows.

35 U.S.C. 101 states as follows,

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Since the claim element of a transmitter is an example of a *machine* and is, thus, one of the four enumerated categories of patentable subject matter described in 35 U.S.C. 101, the alleged issue of non-statutory subject matter must pertain to the usefulness of such a transmitter.

The Applicant notes that it is entirely conventional for communication system transmitters to transmit messages containing control information. In fact, only an extremely simple system, such as an AM broadcast or a walkie-talkie radio, does not transmit control information. Since virtually every communication system transmits control information, the claimed transmitter must necessarily be “useful, tangible, and concrete”, which also meets the requirements for 35 U.S.C. 101. Further, the claim is not written in a manner that explicitly precludes the transmitter from additionally transmitting data (non-control information), or the use of an auxiliary transmitter to transmit data. Finally, it should be noted that extremely complicated communication systems may benefit from the use of a transmitter devoted to control information, for network maintenance.

As noted in the MPEP 2107.02 IV - To properly reject a claimed invention under 35 U.S.C. 101, the Office Action must (A) make a *prima facie* showing that the claimed invention lacks utility, and (B) provide sufficient evidentiary basis for factual assumptions relied upon in making the *prima facie* showing. *In re Gaubert*, 524 F.2d 1222, 1224, 187 USPQ 664, 666 (CCPA 1975). “Accordingly, the PTO must do more than merely question operability – it must set forth factual reasons which would lead one skilled in the art to question the objective truth of the statement of operability.” If the Office Action cannot develop a proper *prima facie* case and provide evidentiary support under 35 U.S.C. 101, a rejection on this ground should not be imposed. See, e.g., *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In the present circumstances, the Office Action merely states that the claimed invention lacks a practical application, without making a *prima facie* case for the statement, and without an evidentiary support.

The claimed invention is a machine, one of the four statutory categories of Section 101, and has a practical utility in many modern communication systems. For these reasons, and because a *prima facie* case for rejection has not been supported, the Applicant respectfully requests that the rejection be removed.

In Section 4 of the Office Action, claims 1 and 4 have been rejected under 35 U.S.C. 102(e) as allegedly anticipated by Dutta (US 6,407,986). The Office Action states that Dutta discloses a code for one of the combination of forward and return channel data rates transmitted in a bulletin board, which reads upon the transmission of a message indicative of the data rate prior to, and independent of the data transmission. The Office Action states that Dutta discloses a processor that compiles user messages for transmission at one of a number of available data rates, which reads upon transmitting said data at said rate during a data transmission channel time interval. The Office Action also states that Dutta discloses a bulletin board network management control message type, which reads upon the claimed message components (frame type, data rate, and time interval). The Office Action states that Dutta's bulletin board indicates one of a calendar date and time slot, which reads upon the claimed frame type reciting one of a link schedule, channel active set, and erasure-indicator-bit. This rejection is traversed as follows.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a

single prior art reference.” *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claims 1 and 4 recite a message that is transmitted independent of a data transmission. The message includes information concerning the data rate and time interval of the data transmission to follow. As support, the Applicant’s specification describes 5 different physical channels, including fundamental and supplemental data channels, and a control channel (page 10, lines 9-11). The control channel would be example of a medium that can carry the above-mentioned “message”.

In contrast, Dutta discloses a bulletin board with the data rates of the forward and reverse channels (col. 14, ln. 29-42). Dutta’s Figs. 6B-6D disclose three different types of frames (A, B, and C). As can be seen in the figures, the bulletin board is always followed by data (col. 14, ln. 43-61). For example, in Fig. 6B, the long bulletin board (LBB 221) is followed by data 218. In Fig. 6C, the short bulletin board (SBB 221) is followed by data 222. Figs. 6E-6G depict superframes, which are composed of various combinations of A and C frames. In summary, Dutta’s bulleting boards are always transmitted in the same frame (superframe) as data. Therefore, even if Dutta’s bulletin board is considered to include data rate, data time interval, and a frame type including link schedule, channel active set, and erasure-indictor-bit, Dutta’s bulletin board is not independent of the data transmission. That is, Dutta’s bulletin board cannot be independent of a data slot that occurs in the same frame, immediately following the bulletin board. Since the data immediately follows the bulletin board, the bulletin board is not independent of the data.

Dutta does not disclose a message that is transmitted independent of a data transmission, wherein the message includes control information such as data rate, time interval, and frame type. Therefore, Dutta does not explicitly disclose each and every limitation of claims 1 and 4. Since Dutta does not explicitly disclose every limitation of claims 1 and 4, he cannot anticipate those claims, and the Applicant respectfully requests that the rejection be withdrawn.

Applicant has reviewed the references made of record and asserts that the claims are patentable over the references made of record. It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Applicant hereby requests a three-month extension of time to file this response to the Office Action issued March 15, 2007. Please charge Deposit Account No. 17-0026 the requisite fee associated with the extension of time. Please charge any additional underpayments or overpayments associated with this paper to Deposit Account No. 17-0026.

Respectfully submitted,

Date: September 5, 2007

/David J. Huffaker/
David J. Huffaker
Registration No. 56,771
Telephone: 858-845-2110

Customer Number 23,696